

REMARKS

This is in response to the Office Action mailed February 27, 2006, in which the Examiner rejected claims 1, 2, 4-6, 8, 9, 11, 12, 14-19, 21-31, 33-38, 40-47 and 50-53. Reconsideration of the application as amended is respectfully requested.

Claim Rejections - 35 U.S.C. §102

In Section 4 of the Office Action, the Examiner rejected claims 1, 2, 5, 6, 8, 14-19, 21-23, 25, 26, 28-31, 34-38, 40, 41, 43-45, 47 and 50-53 under 35 U.S.C. §102(e) as being anticipated by Slocum et al. (U.S. Patent No. 6,430,306). Applicant respectfully believes that the rejections are improper.

The rejections of independent claims 1, 31 and 38 are improper because the standard for establishing a *prima facie* case of anticipation against the claims requires more than a disclosure of a system that is "capable of performing all of the method steps" as stated by the Examiner. Rather, Anticipation of a claimed invention requires the disclosure in a single prior art reference of each element of the claim under consideration. *W. L. Gore & Assocs. V. Garlock*, 721 F.2d 1540, 220 USPQ 330, 313 (Fed. Circ. 1983), *cert. denied*, 469 U.S. 851 (1984). It is not enough, however, that the prior art reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)).

The rejections are improper because the cited reference fails to identically disclose all of the claimed elements. For instance, Slocum et al. fail to disclose a step of "invalidating the card when the verification results indicate that the card was incompletely processed including modifying the card", as described in independent claims 1, 31 and 38. The "means to invalidate the card" cited by the Examiner corresponding to column 18, line 47+ fails to disclose the invaliding step of claims 1, 31 and 38. Should the Examiner disagree with Applicant's assessment of the disclosure, Applicant requests that the Examiner specifically identify where Slocum et al. disclose modifying the card when it is found to be incompletely processed.

Therefore, Applicant submits that Slocum et al. fail to anticipate independent claims 1, 31 and 38, since the reference fails to identically teach all of the claimed elements. Accordingly, Applicant requests that the rejections be withdrawn. Additionally, Applicant requests that the rejections of the claims depending from independent claims 1, 31 and 38 be withdrawn for at least the reasons set forth above.

Applicant further submits that Slocum et al. fail to disclose "a controller configured to generate verification results that are indicative of whether the card was completely or incompletely processed, wherein the controlled modifies the card with the card processing component when the verification results indicate that the card was incompletely processed" as provided in claim 43, or "a controller configured to compare the scanned image data to the print image data and generate verification results that indicate either that the card was completely processed when the scanned image data substantially matches the print image data, or that the card was incompletely processed when the scanned image data does not substantially match the print image data, wherein the controller modifies the card with

the card processing component when the verification results indicate that the card was incompletely processed" as provided in claim 50. Rather, the cited controller (CPU 26) of Slocum et al. fails to make any modification to the card using any of the components of the system once it is discovered that it was incompletely processed or invalid.

Therefore, Applicant submits that Slocum et al. fail to anticipate independent claims 43 and 50, and requests that the rejections be withdrawn. Additionally, Applicant submits that the rejected claims that depend from independent claims 43 and 50 should be withdrawn for at least the reasons set forth above.

Claim Rejections - 35 U.S.C. §103

In Section 7 of the Office Action, the Examiner rejected claims 11, 13, 27, 42 and 46 under 35 U.S.C. §103(a) as being unpatentable over Slocum et al. Applicant submits that the claims are allowable for at least the reasons set forth above with regard to independent claims 1, 38 and 43, from which they depend, and requests that the rejections be withdrawn.

In Section 8 of the Office Action, the Examiner rejected claims 4, 24 and 33 under 35 U.S.C. §103(a) as being unpatentable over Slocum et al. Applicant respectfully believes that the rejections are improper.

The rejected claims are allowable for at least the reasons set forth above with regard to independent claims 1 and 31, from which they depend. Additionally, the Examiner has failed to establish a *prima facie* case of obviousness against the claims, because the cited reference fails to disclose modifying the card in any way including printing on the card after it is determined that it was invalid or incompletely processed. Thus, Slocum et al. fail to disclose "wherein modifying the card includes

printing a voiding mark on the card over the image printed on the card in the processing step a)" as provided in claim 4, printing a voiding mark in the modifying step "wherein the voiding mark includes a word" as provided in claim 24, or "wherein modifying the card includes printing a voiding mark on the card over the image printed on the card in the processing step a)" as provided in claim 33.

Furthermore, the Examiner has failed to establish a *prima facie* case of obviousness against the claims because there is no suggestion or motivation to make the suggested modification of Slocum et al. outside of Applicant's disclosure. Rather than finding the required motivation in Slocum et al. or any other reference cited by the Examiner, the motivation cited by the Examiner comes directly from Applicant's disclosure. Such reliance on Applicant's disclosure to discern the "obviousness" of the claimed invention is clearly improper. *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002) ("It is improper, in determining whether a person of ordinary skill in the art would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'") (quoting *W.L. Gore v. Garlock, Inc.*, 220 USPQ 303, 312-13 (Fed. Cir. 1983)).

Therefore, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness against claims 4, 24 and 33, and requests that the rejections be withdrawn.

Conclusion

In view of the above comments and remarks, Applicant submits that the present application is in condition for allowance. Reconsideration and favorable action is respectfully requested.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

WESTMAN, CHAMPLIN & KELLY, P.A.

By: 

Brian D. Kaul, Reg. No. 41,885
900 Second Avenue South, Suite 1400
Minneapolis, Minnesota 55402-3319
Phone: (612) 334-3222 Fax: (612) 334-3312

BDK/djb